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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/725,240

12/01/2003

Phil R. Stillwell

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08/03/2006

THOMAS, KAYDEN, HORSTEMEYER & RISLEY, LLP
100 GALLERIA PARKWAY, NW
STE 1750
ATLANTA, GA 30339-5948

EXAMINER

PICKETT, JOHN G

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 08/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,240

Applicant(s)

STILLWELL, PHIL R.

Examiner

Gregory Pickett

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action acknowledges the applicant's amendment filed 26 May 2006. Claims 1-14 are pending in the application. The examiner acknowledges and appreciates the applicant's effort to advance the prosecution of the application by incorporating the material agreed upon in the interview of 1 May 2006. However, upon further consideration of the prior art, the examiner regrettably must alter the position previously taken. The rejections based upon this new position are presented below. Accordingly, this action is made **NON-FINAL**.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. In light of the applicant's amendment, the rejection of claims 1-7 under 35 U.S.C. 112, 2nd paragraph is hereby withdrawn.

Claim Rejections - 35 USC § 103

4. Claims 1-3, 5, 6, 8-10, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smicker (US 2,439,149) in view of Isidor et al (US 167,538; hereinafter Isidor) and MV Sport Cap Tee (previously provided).

Claims 1 and 5: Isidor discloses sock-type headwear **A**. Insofar as the headwear is made of a flaccid, plush material (Col 1, 4th paragraph), Isidor is inherently

capable of the storage state, expanded state, and collapsed state claimed by the applicant.

Smicker discloses an article of clothing (Figure 1). Insofar as the clothing is made of a knitted material (Col. 2, lines 16-17), Smicker is inherently capable of being deformed into a cylindrical shape.

In examining the teachings of MV Sport Cap Tee, the examiner looks to MPEP § 2125. The origin of the drawing is immaterial. For instance, drawings in a design patent can anticipate or make obvious the claimed invention, as can drawings in utility patents. The drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art. *In re Aslanian*, 590 F.2d 911, 200 USPQ 500 (CCPA 1979). Accordingly, MV Sport Cap Tee teaches the provision of a shirt, rolled into a cylinder, with a collapsed hat wrapped around the cylinder and secured with a strap. One of ordinary skill in the art would have recognized that the arrangement of MV Sport Cap Tee would enable the presentation of multiple products to the consumer in a unitary package. It therefore would have been obvious to one of ordinary skill in the art to provide the headwear of Isidor and the article of clothing of Smicker in the arrangement as taught by MV Sport Cap Tee in order to present the articles to the consumer in a unitary package.

Claims 8 and 12: Isidor-Smicker-MV Sport Cap Tee, as applied to claims 1 and 5 above, disclose the claimed structures in the claimed arrangement and therefore disclose the claimed packaging methods by presentation.

Claims 2 and 9: MV Sport Cap Tee discloses a strap (item wrapped around the headwear).

Claims 3, 6, 10, and 13: MV Sport Cap Tee discloses the headwear deformed into an arc shape.

5. Claims 4, 7, 11, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Isidor-Smicker-MV Sport Cap Tee as applied to claims 1, 5, 8, and 12 above, and further in view of Kronenbeger (US 6,507,956; previously provided).

Isidor-Smicker-MV Sport Cap Tee discloses the claimed invention except for the headwear deformed into a cylinder. Kronenbeger (see Figure 6) teaches storage of headwear into a cylinder. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of Isidor-Smicker-MV Sport Cap Tee with the headwear deformed into a cylinder in order to reduce the diameter of the package. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

Response to Arguments

6. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

7. The examiner has altered the position taken in the interview of 1 May 2006; in order to give the applicant ample opportunity to respond to this new position, this action is made **NON-FINAL**.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Greg Pickett
Examiner
28 July 2006